

REMARKS

Upon entry of this Amendment, claims 1-11 remain pending and under current examination. In the Final Office Action,¹ the Examiner took the following actions;

- (a) withdrew the previous 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 101 rejections;
- (b) repeated the rejection of claims 1, 3, 9, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff (U.S. Patent No. 6,385,591) (“Mankoff”) in view of DeLuca et al. (U.S. Patent No. 5,870,030) (“DeLuca”);
- (c) repeated the rejection of claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of DeLuca and Golden et al. (U.S. Patent No. 5,761,648) (“Golden”);
- (d) repeated the rejection of claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of the English language “equivalent” (Office Action, p. 3) of Sim (KR2000030358A) (“Sim”);
- (e) repeated the rejection of claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and DeLuca; and
- (f) included a short section entitled “Response to Arguments.”

Applicants traverse the rejections for the following reasons.

Rejection of Claims 1, 3, 9, and 11 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawal of the rejection of claims 1, 3, 9, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of DeLuca. Applicants respectfully disagree with the Examiner’s arguments and conclusions.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 4 (October 2005), p. 2100-134.

The first requirement for establishing a *prima facie* case of obviousness is not met, because Mankoff and DeLuca, taken alone or in combination, do not teach or suggest every feature of Applicants' amended claims.

The Examiner alleges that Mankoff teaches "the concept of a user browsing webpages on the Internet and clicking a banner advertisement to request an electronic coupon be delivered (from a coupon server) to his computer" (Final Office Action, p. 2). The Examiner further alleges that Mankoff teaches redeeming the coupon at a retail establishment "by synchronizing (connecting) the computer to the retailer computer and transferring the coupon to the retailer." Id. The Examiner admits that "[i]t is not clear to what extent the coupon to be redeemed is displayed to a retailer," though the Examiner relies on DeLuca "for such display (to then redeem)." Id.

Mankoff and DeLuca, however, do not teach or suggest at least Applicants' claimed "in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer; in response to the receipt of the identifier, transmitting a coupon to the second computer" (amended claims 1 and 9). That is, Mankoff and DeLuca, taken alone or in combination, do not teach or suggest receiving from the user through the first user computer an identifier associated with a second user computer and transmitting a coupon to a second computer in response to receipt of the identifier.

Instead, Mankoff only teaches transmitting a coupon from a server directly to either a personal computer or a PDA (Fig. 1), or synchronizing a PDA with a personal computer to send coupon offers to the PDA (Fig. 2), or downloading a coupon directly to a PDA from a retail site web server (Fig. 3). Thus, Mankoff does not show that upon display of a banner advertisement to a user of a first computer, that “in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer *an identifier associated with a second user computer*” and “in response to the receipt of the identifier, transmitting a coupon to the second computer” (amended claims 1 and 9, emphasis added).

Likewise, DeLuca only teaches wireless transmission of “ads, information, and messages, as the case may be, to the one-way pager” such that “the message is stored in a message buffer in the pager.” *See* col. 7, line 60 - col. 8, line 10, and generally Figs. 5-9. Further, DeLuca teaches automatic transmission of a multitude of ads to a pager, followed by display of “an advertisement or survey name from among a list of advertisements and surveys [that] appears on the display.” *See* col. 11, lines 3-15. Thus, DeLuca does not show that upon display of a banner advertisement to a user of a first computer, that “in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer *an identifier associated with a second user computer*” and “in response to the receipt of the identifier, transmitting a coupon to the second computer” (amended claims 1 and 9, emphasis added). DeLuca therefore does not cure Mankoff’s deficiencies.

Therefore, the 35 U.S.C. § 103(a) rejection of claims 1 and 9 should be withdrawn. Mankoff and DeLuca, taken alone or together, do not teach or suggest each and every element of independent claims 1 and 9, as amended. Independent claims 1 and 9 are therefore nonobvious, for the reasons argued above, and dependent claims 3 and 11 are also nonobvious at least by

virtue of their respective dependence from nonobvious base claims 1 and 9. Therefore, Applicants request that the 35 U.S.C. § 103(a) rejection of claims 1, 3, 9, and 11 be withdrawn.

Rejection of Claims 2 and 10 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawal of the rejection of dependent claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of DeLuca and Golden. Applicants respectfully disagree with the Examiner's arguments and conclusions. Furthermore, Mankoff, DeLuca, and Golden, taken alone or in combination, do not teach or suggest every feature of Applicants' amended independent claims 1 or 9, from which claims 2 and 10 respectively depend.

Applicants have already demonstrated previously herein that Mankoff and DeLuca do not teach or suggest all the elements of independent claims 1 and 9. In addition, the Examiner admitted that "Mankoff et al does not teach limiting the number of coupons to be downloaded to the user device" (Final Office Action, p. 3). The Examiner then applied Golden only to specifically teach "a feature whereby the user may download only a certain number of coupons" (Final Office Action, p. 3).

The Examiner's application of Golden, however, fails to cure the deficiencies of Mankoff and DeLuca already discussed. That is, Golden also does not show that upon display of a banner advertisement to a user of a first computer, that "in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer *an identifier associated with a second user computer*" and "in response to the receipt of the identifier, transmitting a coupon to the second computer" (amended claims 1 and 9, emphasis added).

Thus, even if Golden were combined with Mankoff and DeLuca as the Examiner suggests, the combination still does not teach or suggest all elements recited in amended independent claims 1 and 9, and recited indirectly by dependent claims 2 and 10. Therefore, the Examiner's application of Golden as an additional reference does not render obvious the recitations of Applicants' dependent claims 2 and 10.

For at least these reasons, dependent claims 2 and 10 are also nonobvious at least by virtue of their respective dependence from nonobvious base claim 1 and 9, and the 35 U.S.C. § 103(a) rejection should be withdrawn.

Rejection of Claims 4-6 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawal of the rejection of claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim. Applicants respectfully disagree with the Examiner's arguments and conclusions. Furthermore, neither Mankoff nor Sim, taken alone or in combination, teaches or suggest every feature of Applicants' claims.

The Examiner alleges that Mankoff teaches "delivery of electronic coupons to user devices such as PDA's, smart watches[,] Internet appliances and other devices" (Final Office Action, p. 4). The Examiner admits that Mankoff "does not teach delivery to wireless phones," though the Examiner relies on Sim for allegedly teaching "delivery of electronic coupons to wireless phone users." Id.

Mankoff and Sim, however, do not teach or suggest at least Applicants' claimed "in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer; in response to the receipt of the identifier, transmitting the advertisement to the second computer" (amended independent claim 4). In addition, Mankoff and Sim, taken alone or in combination,

do not teach or suggest “inputting information into the second computer, wherein the inputted information directs a third computer to transmit a coupon associated with the advertisement to a computer associated with the inputted information; transmitting the inputted information to the third computer; and transmitting the coupon to the computer associated with the inputted information” (amended independent claim 4).

Instead, Mankoff only teaches transmitting a coupon from a server directly to either a personal computer or a PDA (Fig. 1), or synchronizing a PDA with a personal computer to send coupon offers to the PDA (Fig. 2), or downloading a coupon directly to a PDA from a retail site web server (Fig. 3). Likewise, Sim only teaches “a coupon serving system [which] allows a customer to buy commodities or use services through the use of coupons received in his or her wireless communication terminal equipment” (page 3). Sim therefore does not cure Mankoff’s deficiencies in meeting all of the elements of Applicants’ claim 4.

Because Mankoff and Sim, alone or in combination, do not teach or suggest each and every element of amended independent claim 4, independent claim 4 is nonobvious over the cited references, for the reasons argued above, and dependent claims 5 and 6 are also nonobvious at least by virtue of their dependence from nonobvious base claim 4. Therefore, Applicants request that the 35 U.S.C. § 103(a) rejection be withdrawn.

Rejection of Claims 7 and 8 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawal of the rejection of dependent claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and DeLuca. Applicants respectfully disagree with the Examiner’s arguments and conclusions. Furthermore, Mankoff, Sim, and DeLuca, taken alone or in combination, do not teach or suggest every feature of Applicants’ amended independent claim 4, from which claims 7 and 8 depend.

Applicants have already demonstrated previously herein that Mankoff, Sim, and DeLuca do not teach or suggest all the elements of independent claim 4. Thus, even if the references were combined as the Examiner suggests, the combination still does not teach or suggest all elements recited in amended independent claim 4, and incorporated by dependent claims 7 and 8. Therefore, the Examiner's application of Mankoff, Sim, and DeLuca does not render obvious the recitations of Applicants' dependent claims 7 and 8.

For at least these reasons, dependent claims 7 and 8 are nonobvious over Mankoff, Sim, and DeLuca. These claims are also nonobvious at least by virtue of their dependence from nonobvious base claim 4, and the 35 U.S.C. § 103(a) rejection of claims 7 and 8 should be withdrawn.

Conclusion:

In view of the foregoing, Applicants request reconsideration of the application and withdrawal of the rejections. Because Applicants' amendments and arguments have removed all of the pending rejections, claims 1-11 are in condition for allowance, and Applicants request a favorable action.

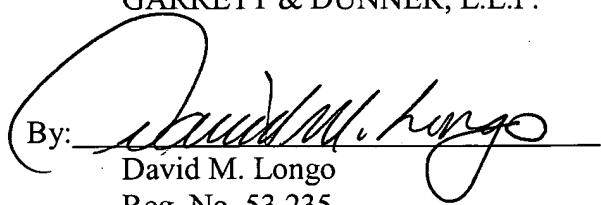
If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
David M. Longo
Reg. No. 53,235

/direct telephone: (202) 408-4489/